

REMARKS

A. Background

The Office Action, dated September 21, 2006, considered claims 1-21. Claim 18 was objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form, incorporating all of the limitations of the base claim and any intervening claims. Claims 1-17 and 19-21 were rejected under 35 U.S.C § 102(e) as being anticipated by *Harrenstein* (U.S. Patent No. 7,085,553).¹ Applicant respectfully traverses this rejection.

B. Claim Status

Applicant has not amended, cancelled or added any claims by this response. Accordingly, following this paper, claims 1-21 remain pending, of which claims 1 and 12 are the only independent claims at issue.

C. Foreign Priority

As noted in the last responses, the present application claims priority to Swedish Application Serial No. 0100014-0. A certified copy of this application was submitted to the USPTO by Express Mail on March 25, 2002, as shown on the USPTO PAIR system. Applicant notes that the present and all preceding Office Actions do not acknowledge the claim to foreign priority nor receipt of the certified copy of the Swedish application. Applicant thus respectfully requests that the Examiner acknowledge the claim for foreign priority and receipt of the certified copy.

D. Rejection on the Merits

As reflected in the above claim listing, Applicant's invention is generally directed towards embodiments for transmitting packet data in a wireless communication network in a way that takes into account any particular radio transferring capabilities associated with a wireless device in the network. For example, claim 12 recites an exemplary method from the perspective

¹ Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should the need arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

of a wireless device which receives packet data from an originator of information. As recited in claim 12, the wireless device receives, from the originator of information, a request for information relating to the radio transferring capabilities of the wireless communication station. Further, a response to the request is transmitted which includes information relating to the radio transferring capabilities associated with the wireless device.²

While *Harrenstein* generally relates to transferring information through a wireless communication system, it fails to disclose or suggest each and every limitation of the present invention, either expressly, impliedly or inherently, and therefore fails to anticipate the present invention as embodied in the above claims. For example, among other things, *Harrenstein* clearly fails to disclose or suggest a request from an originator of information for information relating to the radio transferring capabilities of the wireless communication station, as claimed in combination with the other claim elements.

In particular, *Harrenstein* discloses an intelligent paging system in which a server provides automatic notifications to a mobile client station of the type and quantity of information awaiting delivery to the mobile client. For example, an exemplary method is disclosed in which information intended for the client is received or generated by the server. (Col. 5, ll. 19-20). Once the information is obtained, the server generates a signal that includes a message to the client that there is a message waiting for the client to pick-up, and a telephone address of the client for which the information is waiting. (Col. 5, ll. 20-27). The generated message can also include information relating to the information to be picked-up by the client. For instance, the message may include the type of information waiting (e.g., email) and the size of the waiting message (e.g., byte size). (Col. 6, ll. 7-17). This size and type information may be provided in numeric and alpha form so that the message can be interpreted directly by the client and displayed to the user of the client for his or her review to decide whether to connect to the server and retrieve the information. (Col. 5, ll. 43-58). If the waiting information is of a type and size that justify the cost of establishing the communication link, a communication link established with the server, and the client logs-in to the server. (Col. 6, ll. 53-60). Once the log-in is complete, the client transmits a request to the server to retrieve the waiting information. (Col. 6, ln. 66 to Col. 7, ln. 5). Thus, *Harrenstein* teaches a method and system in which network

² Independent claim 1 recites a method corresponding to the method of claim 12, but which is recited from the perspective of the server.

messages are shared based on a determination of whether the type and size of the information to be transmitted justifies the cost of establishing a wireless communication link.

The independent claims of the present invention, on the other hand, relate to a method of a wireless device which receives a request for its radio transferring capabilities and transmits a response to the request which includes the radio transferring capabilities of the wireless device (claim 12), and a method of a server which requests the radio transferring capabilities of the wireless device and adapts the information content to be transmitted to the wireless station based upon the response from the wireless station to the request (claim 1). That is, the request asks for the wireless device's radio transferring capabilities, the response provides the radio transferring capabilities, and the information content is adapted to the radio transferring capabilities of the wireless device. Thus, each of the independent claims relates to requesting or transmitting radio transferring capabilities and transferring information content adapted to the radio transferring capabilities.

In contrast, however, *Harrenstein* relates to a server transmitting information about the message to be sent, namely its type and byte size, and the client thereafter submitting a request for the waiting information. Thus, the request in *Harrenstein* is for the client to respond as to whether it wants to receive the waiting information, *NOT* a request for radio transferring capabilities of the wireless device, as recited in combination with the other claim elements. Moreover, the request from the client is a request to retrieve the waiting information, and does not include radio transferring capabilities of the wireless device. Accordingly, inasmuch as the request from the client is merely an affirmative answer to the server's request as to whether the client wants to retrieve the information, *Harrenstein* also fails to teach wherein the information content is then adapted based on a response from the wireless device relating to the wireless device's radio transferring capabilities.

Applicant also notes that with respect to claim 12, the Office Action appears to assert that it is inherent that "radio transferring capability of the wireless station is inherent in the server." (Office Action, p. 4). Applicant respectfully disagrees.

In particular, "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." (M.P.E.P. § 2112(IV)). Accordingly, to rely on the theory of inherency, the Office "must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." (M.P.E.P. §

2112(IV)). In the Office Action, an assertion is made that the radio capability of the wireless station is inherent in the server, without any provided "basis in fact" or "technical reasoning." Instead, the Office Action appears merely to conclude, without any accompanied reasoning, that the feature is present.

Moreover, if such a feature is inherent, Applicant submits that the alleged inherent characteristic, when combined with the express and implicit teachings of *Harrenstein*, fails to disclose or suggest each and every limitation of the claimed invention. In particular, the Office Action appears to allege, without further explanation, that it is inherent that radio transferring capabilities of the wireless station are inherently in the server. Accordingly, the Office Action alleges that the server already has information relating to the radio transferring capabilities of the wireless device, such that it would be unnecessary, and arguably undesirable, for the server to query the wireless device for such information. Thus, assuming the Office Action's assertion of inherency to be true, it actually teaches away from the claimed embodiments that require a request/response related to the radio transferring capabilities. In other words, if the radio transferring capability of the wireless station is already inherently in the server, why would the server then also request that same information from the wireless station?

Moreover, the Office Action asserts that it is inherent that the transceiver of the client in *Harrenstein* has radio transferring capabilities. (See Office Action, p. 3, relating to claims 3-6 and 13-16). Even accepting this as true, the mere fact that a device has such capabilities, does not necessitate that they be requested by, and thereafter sent to, an originator of information content, or that the information content be adapted based on such information. For example, as disclosed in *Harrenstein*, a message can be sent to the user of the client device providing information on the waiting information such that the user can then determine whether or not to retrieve the information. As it is unlikely that any user of a wireless device has the information on the particular radio transferring capabilities of the wireless device, it is also unlikely, and clearly not necessary, that the user also indicate the wireless device's capabilities. Accordingly, any assertion that the *Harrenstein* system includes a request for radio transferring capabilities by the server, from the wireless device, is mere speculation, and appears to be based on a review of Applicant's disclosure rather than the state of the art or on knowledge of one of ordinary skill in the art. Indeed, it is not necessary that the wireless device receive and respond with such a request inasmuch as, as disclosed in *Harrenstein*, the wireless device could, in fact, merely

receive a request for a response regarding whether it should send available information and, if desired, respond in the affirmative, requesting that the server send such waiting information.

For at least the foregoing reasons, Applicant therefore respectfully submits that the cited art fails to teach or suggest each and every limitation of the claimed invention as recited in the independent claims. In view of the foregoing, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned by telephone at (801) 533-9800.

Dated this 19th day of January, 2007.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jens C. Jenkins", with a stylized flourish at the end.

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